

REMARKS

Applicants acknowledge receipt of the Office Action mailed April 3, 2009.

In the Office Action, the Examiner rejected claims 1-3¹, 6, 9-16, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over *Kelly et al.* (U.S. Patent Pub. No. 2002/0121683) in view of *Roberts et al.* (U.S. Patent No. 6,335,548); and objected to claims 17-19 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this Amendment, Applicants amend claims 1 and 10. Claims 1-4, 6, and 9-23 remain pending. Of these claims, claims 1 and 10 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1 and 10. No new matter has been introduced.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claims 17-19. However, Applicants have not rewritten claims 17-19 to include all of the limitations of the base claim and any intervening claims because independent claims 1 and 10 are patentably distinguishable over the cited prior art.

Based on the foregoing amendments, Applicants traverse the rejection above and respectfully request reconsideration for at least the reasons that follow.

I. 35 U.S.C. § 103(a) REJECTION

Applicants traverse the rejection of claims 1-4, 6, 9-16, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over *Kelly* in view of *Roberts*. Applicants

¹ Applicants note that dependent claim 4 should also be listed in the listing of rejected claims. Applicants request that the Examiner address this issue in the next communication.

respectfully disagree with the Examiner's arguments and conclusions and submit that independent claims 1 and 10 are patentably distinguishable over *Kelly* and *Roberts* at least for the reasons described below.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Independent claim 1, and similarly independent claim 10, recites an optoelectronic component comprising: "an electrically conductive frame forming a base including multiple separate base sections for an assembly . . . , wherein the base emanates from an internal middle portion and each of the base sections protrudes from a bottom surface and at least one of two other side surfaces of the housing."

Kelly appears to disclose a semiconductor device package 10 including a minimal length of bond wires 20 and 22 between terminals 14 and 16 and an attached device 30. By reducing the length of the bond wires 20 and 22 and selecting the appropriate dielectric constant of the encapsulant 12, the invention provides a package 10 with a unique hexagonal structure that limits the effects of parasitics and provides good thermal dissipation. (*Kelly*, Abstract).

As admitted by the Examiner, however, "Kelly does not explicitly teach an opaque plastic or . . . where the base protrudes past [t]he bottom surface of the housing." (*Office Action*, p. 3, II. 1-2). *Kelly* also fails to teach or suggest at least an optoelectronic component with a base including multiple separate base sections for an assembly, wherein the base emanates from an internal middle portion and each of the base sections protrudes from a bottom surface and at least one of two other side surfaces of the housing.

In order to cure the deficiencies of *Kelly*, the Examiner relies on *Roberts* and alleges "Roberts teaches that opaque plastic have better heat resistant properties than transparent plastics . . . Robert further teaches a heat extraction member to help with

heat dissipation that extend past the bottom surface of the housing.” (*Office Action*, p. 3, II. 3-6). Such teaching, even if present in *Roberts*, however, does not constitute or suggest at least an optoelectronic component comprising: “an electrically conductive frame forming a base including multiple separate base sections for an assembly . . . , wherein the base emanates from an internal middle portion and each of the base sections protrudes from a bottom surface and at least one of two other side surfaces of the housing,” as recited in claim 1, and similarly claim 10.

As explained above, the elements of independent claims 1 and 10 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 1 and 10. Claims 1 and 10, and claims 2-4, 6, 9, 11-16, and 20-23 which correspondingly depend therefrom, are patentable over *Kelly* and *Roberts*. Applicants therefore request that the rejection of claims 1-4, 6, 9-16, and 20-23 under 35 U.S.C. § 103(a) be withdrawn.

II. CONCLUSION

Applicants respectfully submit that claims 1-4, 6, and 9-23 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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